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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,086	12/09/2005	Magali Bou	0521-1029	1216

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YOUNG & THOMPSON
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EXAMINER	
LILLING, HERBERT J	

ART UNIT	PAPER NUMBER
1657	

MAIL DATE	DELIVERY MODE
09/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/560,086	BOU ET AL.	
	Examiner	Art Unit	
	HERBERT J. LILLING	1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-17* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Receipt is acknowledged of a preliminary amendment filed December 09, 2005 and two prior art information disclosure statements filed December 09, 2005 and June 19, 2006 in this application which application is a 371 of PCT/FR04/01421 filed 06/09/2004 which claims benefit to FR 03/07046 filed June 12, 2003.

2. Claims 1-17 are pending in this application.

3. The preliminary amendments to the "CURRENT AMENDED" claims 3, 7-9, 12-14 and 17 are improperly amended. Applicant is required to submit a proper request for amendment to the claims in accordance with MPEP § 1.121 Manner of making amendments in applications. :

> "(c) Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered)"

Examiner will submit the following restriction requirement based on the proposed amendments which are required in the next office action to submit the proper format as noted above.

4. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, drawn to **lactic bacterial strain** belonging to the genus Lactobacillus, classified in Class 435, subclass 252.9 or Pediococcus, classified in Class 435, subclass 252.1.

Group II, claim(s) 9, drawn to **preparation** comprising strain and wine, classified in Class 426, subclass 61.

Group III, claim(s) 10-16, drawn to a method of converting malic acid into lactic acid in a wine, classified in class 426, subclass 11.

Group IV, claim(s) 17, drawn to wine, classified in Class 426, subclass 592.

5. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a **serious search and examination burden** if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification for the above four Groups;

(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter in view of the differences between the various products as well as the methods whereby the strain(s) of Invention I can be employed for different processes other than the process claimed in accordance with the following from the MPEP:

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h).

;

(c) the inventions require a different field of search as noted above a) as well as the above different Groups I-IV requires different search queries for the various data bank bases which are essentially required that involves a very serious burden for the search and examination of numerous data bank bases involving different search strategies for each of the above Groups ;

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention**.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement

will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

In addition, the claimed subject clearly indicates that this application inventions or groups of inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1 as evidenced by the prior art of record.

6. This application contains claims directed to the following patentably distinct species

A. Whereby the strain is selected from

a) genus Lactobacillus;

If elected further election selected from the group consisting of:

. i) Lactobacillus casei,

ii) Lactobacillus delbruckii,

iii) Lactobacillus planatarum,

If elected further election of subspecies,

iiia) DSM-9916,

iiib) other-please specify,

iv) other please specify.

b) genus Pediococcus;

If elected further election selected from the group consisting of:

i) Pediococcus acidilactici,

if elected please elect one of the subspecies:

ia) CNCM MA 18/5M

ib) other species please specify.,

ii) Pediococcus damnceus,

iii) Pediococcus pentosaceus,

iv) Pediococcus parvulus,

v) Pediococcus cerevisiae.,

vi) other please specify.

c) other genus- please specify.

B. Whereby the preparation comprises the following strain(s):

a) genus Lactobacillus;

If elected further election selected from the group consisting of:

. i) Lactobacillus casei,

ii) Lactobacillus delbruckii,

iii) Lactobacillus planatarum,

If elected further election of subspecies,

iiia) DSM-9916,

iiib) other-please specify,

iv) other please specify.

b) genus Pediococcus;

If elected further election selected from the group consisting of:

i) Pediococcus acidilactici,

if elected please elect one of the subspecies:

ia) CNCM MA 18/5M

ib) other species please specify.

ii) Pediococcus damnceus,

iii) Pediococcus pentosaceus,

iv) Pediococcus parvulus,

v) Pediococcus cerevisiae.,

vi) other please specify.

c) other genus- please specify.

d) any combination of the above-please specify the combination of strains.

7. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 9, 10 and 17 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would

not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. In accordance with this Tech Center Policy based on above restriction containing product claims and process claims, this Examiner will rejoin any non-elected process claims upon the election of a product claim which is subsequently is found allowable in view of the following guidelines:

F.P.: Ochiai/Brouwer Rejoinder form paragraph

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is

found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

10. Applicant will probably be required to be in full compliance with

Rules of Deposits in accordance with the following:

U.S. Patent Rules of Deposits

It is apparent that strain(s) is required to practice the claimed invention(s) as recited in the claims. As a required element it must be known and readily available to the public or obtainable by a repeatable method set forth in the specification. If it is not so obtainable or available, the enablement requirements of 35 U.S.C. 112, first paragraph, may be satisfied by a deposit of strain(s). See 37 C. F. R. 1.802.

The specification does not provide a repeatable method for obtaining the strain(s) and it does not appear to be a readily available material. Deposit of strain(s) would satisfy the enablement requirements of 35 U.S.C. 112. If a deposit has been made, Applicant is required to meet the necessary criteria of the deposit rules in accordance with 37 CFR 1.801-37 CFR 1.809.

If a deposit has not been supplied or made under the Budapest Treaty, then an affidavit or declaration by Applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty **and that all restrictions** imposed by the depositor on the availability to the public of the deposited material will be **irrevocably removed** upon the granting of a patent, would satisfy the deposit requirements, See 37 CFR 1.808.

If a deposit is not made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made at an acceptable depository and that the following criteria have been met:

a) during the pendency of the application, access to the deposit will be afforded to one determined by the Commissioner to be entitled thereto;

b) all restrictions imposed by the depositor on the availability to the public of the deposited material **will be irrevocably** removed upon the granting of a patent;

c) the deposit will be maintained for a term of at least thirty (30) years and at least five (5) years after the most recent request for the furnishing of a sample of the deposited material;

d) a viability statement in accordance with the provisions of 37 CFR 1.807;

and

e) the deposit will be replaced should it become necessary due to inviability, contamination or loss of capability to function n the manner described in the specification.

In addition, the identifying information set forth in 37 CFR 1.809(d) should be added to the specification, See 37 CFR 1.803-37 CFR 1.809 for additional explanations of these requirements.

> Please note that the mere reference to a deposit or the biological material itself in any document or publication does not necessarily mean that the deposited biological material is readily available. Even a deposit made under the Budapest Treaty and referenced in a United States or foreign patent document would not necessarily meet the test for known and readily available unless the deposit was made under conditions that are consistent with those specified in these rules, including the provision that requires, with one possible exception (37 CFR 1.808(b)), that all restrictions on the accessibility be irrevocably removed by the applicant upon the granting of the patent. Ex parte Hildebrand, 15 USPQ2d 1662 (Bd. Pat. App. & Int. 1990).

11. Applicant is advised that this Examiner will require that the specification contain sufficient information pertaining to the inherent properties of the two deposits in accordance with the following:
"....the **identifying information set forth in 37 CFR 1.809(d)** should be added to the specification, See 37 CFR 1.803-37 CFR 1.809 for additional explanations of these requirements."

The specification will probably be rejected based on the lack of identifying properties for a proper search and examination for the claimed product species for Inventions I, II and IV which includes the generic genus as well as the deposited strain(s).

Absent the identifying properties, this Examiner will not be able to examine any of the product claims to make a reasonable search and examination of the required strain(s) commensurate in scope the claimed language in view of the specification that lacks the properties.

In addition, Applicant must be in compliance with the above availability especially for claims 5 and 14-16 as well as under best mode requirement of 35 USC 112 first paragraph for the strain(s). For the method Invention, a search and examination will be made and allowed if no art is found and the availability statement is made of record since anyone may practice the instant invention by obtaining the strain from the Depository.

12. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HERBERT J. LILLING whose telephone number is 571-272-0918. The examiner can normally be reached on WORK AT HOME MAXIFLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JON WEBER can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit **1657**
August 24, 2008

/HERBERT J LILLING/
Primary Examiner Art Unit 1657